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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KOICHI NAGOSHI, TAKAYUKI FUKUSHIMA,
IKUO YOSHIDA, TAKESHI OOTSUKA and KIYOHICO HONDA

Appeal 2009-014753
Application 10/663,688
Technology Center 2100

Before ROBERT E. NAPPI, DENISE M. POTHIER, and
JULIE K. BROCKETTI, *Administrative Patent Judges*.

BROCKETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Introduction

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 28, 29, 36-48 and 55-63. Claims 1-27, 30-35 and 49-54 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

Exemplary Claim

Exemplary independent claim 28 under appeal reads as follows:

28. A multifunction apparatus having at least a scanning function and not having a facsimile transmission function, the multifunction apparatus connected with a server via a network, the server storing information regarding a menu, the menu being displayable on the multifunction apparatus, the multifunction apparatus comprising:

a scanner configured to scan a document;

a panel configured to display a menu representing functions of the multifunction apparatus; and

a controller configured to communicate with the server, to receive the information regarding the menu from the server, and to display a menu on the panel based on the information regarding the menu received from the server,

the controller being further configured to send, to the server, based on the information regarding the menu, scanned image data with predetermined information indicating another multifunction apparatus having a facsimile transmission function and being capable of transmitting the image data to a receiving apparatus by facsimile transmission, when a predetermined menu indicating a facsimile transmission function is displayed on the panel of the multifunction apparatus, the information regarding the menu including the predetermined menu indicating the facsimile transmission function, and when a facsimile transmission is selected on the predetermined menu,

whereby the server transmits, to the another multifunction apparatus, the image data scanned by the multifunction apparatus, based on the predetermined information, the server being distinct from the multifunction apparatus and from the another multifunction apparatus.

Rejection on Appeal

The Examiner rejected claims 28, 29, 36-48 and 55-63 under 35 U.S.C. § 103(a) as being unpatentable over Kitada (US 2004/0024811 A1) in view of Tanimoto (US 6,885,469 B1).

Appellants' Contentions

(1) Appellants contend that the Examiner erred in rejecting claims 28, 37-40, 45, 55 and 57-59¹ because:

“KITADA, particularly as described in the first embodiment thereof, clearly has a facsimile transmission capability.”

(App. Br. 17).

“The fax server 80 is not a multifunction device but a server and cannot reasonably be considered to be a multifunction device, particularly where, as here, KITADA explicitly distinguishes between the multifunction devices 10, 20, and 30 and the fax server 80.”

(App. Br. 17).

“[T]here is no sending of ‘scanned image data with predetermined information indicating another multifunction apparatus having a facsimile transmission function’ as recited by the pending claims.”

¹ Separate patentability is not argued for dependent claims 37-40, 45, and 57-59. According, we select claim 28 as representative and group these claims with claim 28. *See* 37 C.F.R. § 41.37(c)(1)(vii).

(App. Br. 19, 20).

“While the examiner relies upon TANIMOTO to teach transmitting the image data to the receiving apparatus by facsimile transmission, this feature is not taught by TANIMOTO.”

(App. Br. 23).

(2) Appellants contend that the Examiner erred in rejecting claim 29 because:

The prior art does not teach scanning a document when the facsimile transmission is selected on the menu. (App. Br. 29).

(3) Appellants contend that the Examiner erred in rejecting claims 36 and 56 because:

The prior art does not teach that the information regarding the menu is utilized for the multifunction apparatus and for another multifunction apparatus. (App. Br. 30).

(4) Appellants contend that the Examiner erred in rejecting claims 41 and 42² because:

The prior art does not teach a job ID. (App. Br. 31).

(5) Appellants contend that the Examiner erred in rejecting claims 43, 44, 46 and 62³ because:

The prior art does not teach job parameters with respect to the features of copying, printing and facsimile transmission. (App. Br. 32, 33).

² Claim 42 is not separately argued from claim 41. According, we select claim 41 as representative and group claim 42 with claim 41. *See* 37 C.F.R. § 41.37(c)(1)(vii).

³ Appellants have grouped claims 43, 44, 46 and 62 together in their arguments (App. Br. 32). According, we select claim 43 as representative and group claims 44, 46 and 62 with claim 43. *See* 37 C.F.R. § 41.37(c)(1)(vii).

(6) Appellants contend that the Examiner erred in rejecting claim 47 because:

The prior art does not teach a maximum number of characters that can be displayed on the display of the multifunction apparatus. (App. Br. 34).

(7) Appellants contend that the Examiner erred in rejecting claim 48 because:

“none of the profile items of information...relate to the capabilities of the multifunction apparatus.” (App. Br. 35).

(8) Appellants contend that the Examiner erred in rejecting claim 60 because:

The prior art does not teach transmitting a job execution result upon completion of facsimile transmission. (App. Br. 36).

(9) Appellants contend that the Examiner erred in rejecting claim 61 because:

The prior art does not teach image data and a job parameter being transmitted by the server to “another multifunction apparatus.” (App. Br. 37).

(10) Appellants contend that the Examiner erred in rejecting claim 63 because:

The prior art does not teach that the “another multifunction apparatus” transmits, to the receiving apparatus, the image data scanned by the multifunction apparatus based on the job parameter. (App. Br. 38).

Issues on Appeal

Did the Examiner err in rejecting claims 28, 29, 36-48 and 55-63 because Kitada and Tanimoto fail to teach or suggest the disputed claim limitations?

ANALYSIS

We have reviewed the Examiner's rejections in light of the Appellants' arguments (Appeal Brief and Reply Brief) that the Examiner has erred. We disagree with Appellants' conclusions.

Claims 28 and 55

Appellants contend that unlike the multifunction device of Appellants' claims which recite that the multifunction device does not have facsimile transmission capability, Kitada's multifunction devices have facsimile transmission capability. (App. Br. 17). The Examiner notes that Kitada teaches of an embodiment in which the multifunction device described does not include a fax. (Ans. 8). Kitada describes a multifunction device that can include a multiple scanner, photocopier and printer but not a fax machine (*See* Kitada ¶0023 ll. 15-17). Under the teachings of Kitada, this type of multifunction device sends an image and other data to a scan server which then sends the data to a fax server for facsimile transmission to a recipient. (*Id.* ¶0026). Consequently, it operates the same as Appellants' device in that the data to be faxed is routed from an initial multifunction device that does not by itself have facsimile transmission capability to another device that does have facsimile transmission capability.

Appellants further contend that the fax server of Kitada is not a multifunction device. (App. Br. 17). We note that the Examiner is using the fax server 80 of Kitada to illustrate that it is well known for a multifunction device that does not include facsimile transmission capabilities to send data to the fax server for facsimile transmission to a recipient. On the other hand, the Examiner is using

Tanimoto to illustrate that a fax server can be a multifunction apparatus. (Ans. 9). As seen in Fig. 1 of Tanimoto, the fax server also includes a printer and a scanner. Therefore, we agree with the Examiner that it would be obvious for one of ordinary skill in the art could use a multifunctional fax server as taught by Tanimoto as the fax server of Kitada for facsimile transmissions. We find Appellants' arguments regarding Tanimoto unpersuasive since the Examiner is using Tanimoto merely to illustrate that a fax server can be a multifunction device and not for the reasons articulated by Appellants in the Appeal Brief.

Appellants further contend that Kitada does not teach sending scanned image data with predetermined information indicating another multifunction apparatus having a facsimile transmission function. (App. Br. 19, 20). We disagree and find that Kitada teaches sending scanned image data along with a request that data be faxed to a specific fax number. Appellants have not provided a specific definition regarding "predetermined information." Thus, the predetermined information can include Kitada's request that the document be faxed as well as the fax number. Consequently, the predetermined information in Kitada indicates that the scanned image should be faxed and, as such, indicates that it will need to be routed to the fax server (i.e. the apparatus with a facsimile transmission function). The scan server receives this information and routes the scanned document to the fax server. (See Kitada ¶¶ 0026, 0047). Furthermore, we note that our interpretation of "predetermined information" is consistent with Appellants' own specification citations noted in the Appeal Brief for this claim element. (App. Br. 10).

Notably, independent claims 28 and 55 recite "the server storing information regarding a menu[.]" We find that this information regarding the menu is non-

functional descriptive material.⁴ Our reviewing court has held that non-functional descriptive material cannot lend patentability to an invention that would have otherwise been anticipated by the prior art. *See In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004). *Cf. In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). The content of non-functional descriptive material is not entitled to weight in the patentability analysis. *See In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994) (“Lowry does not claim merely the information content of a memory.”). *See also Ex parte Nehls*, 88 USPQ2d 1883, 1887-90 (BPAI 2008) (precedential) (discussing non-functional descriptive material).

Claim 29

Appellants contend that Kitada does not teach scanning a document when the facsimile transmission is selected on the menu. (App. Br. 29). We disagree. Kitada teaches multifunctional devices that scan and allow faxes to be sent via a fax server. We find that it is implicit that when a user selects the option to fax a document via the menu displayed in Fig. 5 of Kitada, the document must be first scanned prior to the fax server transmitting the fax. Consequently, it is obvious to scan the document when the fax selection is made on the menu.

Claims 36 and 56

⁴ Some of the dependent claims attempt to further limit what the information regarding the menu contains. While the Examiner has found many of the limitations in the prior art, we note that it is unnecessary as these limitations are not entitled to patentable weight.

Appellants contend that Kitada does not teach that the information regarding the menu is utilized for the multifunction apparatus and for another multifunction apparatus. (App. Br. 30). We disagree. The Examiner cites to paragraphs 0027 and 0033 of Kitada which teach that displays on the multifunction apparatuses allow users to e-mail, fax and perform other functions. (Ans. 9). Based on this teaching, we conclude that Kitada suggests these capabilities are displayed on the menus across all multiple multifunction devices. Furthermore, although not expressly mentioned by the Examiner, we draw Appellants' attention to paragraph 0025 of Kitada which teaches that all of the multifunction apparatuses have access to the company's global directory (e.g., a menu) stored on the directory server. Therefore, all of the multifunction devices utilize the same information in a menu. *See In re Heck*, 699 F.2d 1331, 1333 (Fed. Cir. 1983) (explaining that patents are "relevant for all they contain.")

Claims 41 and 42

Appellants contend that Kitada does not disclose a job ID. (App. Br. 31). We disagree. The Examiner states that Kitada teaches tracking jobs. (Ans. 9). Kitada also teaches of a job log. (*See* Kitada ¶0043, ll. 19-21). We find that it is inherent in keeping a job log that each job is associated with a job ID.

Claims 43, 44, 46 and 62

Appellants contend that Kitada does not teach job parameters with respect to the features of copying, printing and facsimile transmission. (App. Br. 32, 33). We disagree. The Examiner points to Kitada as illustrating various job parameters. (Ans. 9). Kitada clearly states that scanning parameters including paper size and resolution settings. (*See* Kitada ¶0039, ll. 5-12). We find that it is well known to

one of ordinary skill in the art to apply these parameters also to copying, printing and facsimile transmission functions. We note that claim 62 is dependent on claim 61 in which we affirm the Examiner's rejection of claim 61. As such, the Examiner's rejection of claim 62 is affirmed as discussed above.

Claim 47

Appellants contend that the prior art does not teach a maximum number of characters that can be displayed on the display of the multifunction apparatus. (App. Br. 34). We find that this limitation is non-functional descriptive material and as discussed above is not entitled to any patentable weight.

Claim 48

Appellants contend that the prior art does not teach that the information regarding the menu contains information regarding the capabilities of the multifunction apparatus. We disagree. As stated above, we find that this limitation is non-functional descriptive material and as discussed above is not entitled to any patentable weight. However, we note that Fig. 3 of Kitada clearly shows that the menu states the capabilities of the multifunction apparatus in that it lists the choices of facsimile and e-mail.

Claim 60

Appellants contend that the prior art does not teach a job execution result upon completion of facsimile transmission. (App. Br. 36). We disagree. The Examiner has applied Tanimoto to illustrate this limitation in that a job execution result (i.e. error in execution) is displayed when an error is detected. (Ans. 9). We

find reporting an error in the execution of a facsimile transmission is a job execution result.

Claim 61

Appellants contend that the prior art does not teach image data and a job parameter being transmitted by the server to “another multifunction apparatus.” (App. Br. 37). We disagree. Kitada clearly discloses that the image data and the instruction that the image be faxed to a particular recipient (i.e., job parameter) is transmitted from the multifunction apparatus to the scan server and then routed to the fax server (i.e., the another multifunction apparatus). (*See* Kitada ¶0026).

Claim 63

Appellants contend that the prior art does not teach that the another multifunction apparatus transmits, to the receiving apparatus, the image scanned by the multifunction apparatus based on the job parameter. (App. Br. 38). We disagree. The Examiner states that Kitada teaches the image data to be scanned and sent to the another apparatus based on parameters set. (Ans. 10). We further clarify that in Kitada the fax server sends the image scanned by the multifunction apparatus to a receiving apparatus based on the request to fax and whom to fax it to (i.e., job parameters). (*See* Kitada ¶0026, ll. 6-8, ¶0034, ll. 16-19, ¶0047)

CONCLUSIONS

(1) The Examiner has not erred in rejecting claims 28, 29, 36-48 and 55-63 as being unpatentable under 35 U.S.C. § 103(a).

(2) Claims 28, 29, 36-48 and 55-63 are not patentable.

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DECISION

The Examiner's rejection of claims 28, 29, 36-48 and 55-63 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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